

## **REMARKS**

### **I. Introduction**

Claims 1 to 12 are currently pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1 to 12 Under 35 U.S.C. § 112, first paragraph**

Claims 1 to 12 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The gist of this rejection is that the Examiner does not understand the meaning of “indirect selection of control parameters,” assumes that both a direct and indirect selection refer to addressing a particular memory location by a direct mapping of one or more bits to the particular memory location, and therefore cannot discern a difference between an indirect selection as recited in claim 1, and a direct selection as recited in claim 2.

Applicant respectfully submits that this claim is readily understood by those of ordinary skill in the art. Claims are not to be read in a vacuum, but in light of the specification. When this prescription is followed, and the claim is read in light of what the specification teaches, especially that which is taught, e.g., at page 2, lines 2 to 6, Applicant submits that the Specification provides support for this limitation, and that one of ordinary skill in the art would be able to reasonably discern the scope of coverage of claim 1.

The Specification teaches that a direct selection refers to a selection of a particular memory location based on a direct assignment of one or more bits to that memory location. For example, two bits provide four possible combinations. With a direct assignment of bits to memory locations, four memory locations can be alternatively addressed. By contrast, an indirect selection refers to a selection of a particular memory location based on an identification of a particular vehicle version. Accordingly, the values of the same two bits do not refer to particular memory locations, but rather identify one of four possible vehicle versions. Instead of addressing one of four memory locations, a processing unit may address one of four memory locations for each of numerous memory location sets. For example, the processing unit may refer to numerous categories of vehicle functions or devices. A different set of memory locations may be assigned to each category of vehicle functions or devices. During processing, the processing unit may refer to different ones of the memory sets according to an algorithm. Accordingly, based on the algorithm, the processing unit may provide for reading out different memory locations for the same two bit

combination of the vehicle version code, depending on the step of the algorithm being executed.

Accordingly, the Specification provides support for the features recited in claim 1. Withdrawal of this rejection is therefore respectfully requested.

### **III. Rejection of Claims 1 to 5, and 7 to 11 Under 35 U.S.C. § 103(a)**

Claims 1 to 5, and 7 to 11 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Volkswagen official repair manual for model year 1999 Jetta/Golf/GTI (the “Manual”) and U.S. Patent No. 5,513,107 (“Gormley”). It is respectfully submitted that the combination of the Manual and Gormley does not render unpatentable the present claims for the following reasons.

The Office Action incorrectly asserts that the discussion in the Manual regarding a code discloses an indirect selection of control parameters by algorithmic processing of values of a plurality of bit positions, and means therefore. The code, described at page 1-32, is unrelated to a codeword stored in memory having a plurality of bit positions. Unlike bits, a position in the code of the Manual can include values other than 0 and 1. The code described at page 1-32 refers to the keying in by a user of a code. Each number keyed in by the user is presumably assigned a particular value such as a 7 or 8 bit ASCII value. The Manual provides no indication as to how bits that may represent the entered code are stored or processed. Therefore, the Manual is unrelated to claim 1 and does not disclose or suggest an indirect selection of control parameters by algorithmic processing of values of bit positions.

Furthermore, the table at page 1-32 indicates that for each value in a code position or position-combination, the value is directly assigned to particular equipment, a market version, cylinders, or a distance impulse number. The code is not processed so that a single value can refer to different things depending on the step of an algorithm being executed. Accordingly, even if the Manual would refer to a selection, which Applicant does not concede, the Manual still would not refer to an *indirect* selection.

Accordingly, the Manual does not disclose or suggest an “*indirect* selection of control parameters . . . by algorithmic processing of values of a plurality of *bit positions* of the version coding,” as recited in claim 1, or “selecting control parameters of the vehicle version *by algorithmic processing* of values of a plurality of *bit positions* of the version coding,” as recited in claim 7.

Since Gormley does not overcome the deficiencies noted above with respect to the Manual, it is respectfully submitted that the combination of the Manual and Gormley does not render unpatentable either of claims 1 and 7.

As for claims 2 to 5 which depend from claim 1 and therefore include all of the features recited in claim 1, it is respectfully submitted that the combination of the Manual and Gormley does not render unpatentable these dependent claims for the same reasons set forth above in support of the patentability of claim 1. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (any dependent claim that depends from a non-obvious independent claim is non-obvious).

As for claims 8 to 11 which ultimately depend from claim 7 and therefore include all of the features recited in claim 7, it is respectfully submitted that the combination of the Manual and Gormley does not render unpatentable these dependent claims for the same reasons set forth above in support of the patentability of claim 7. *Id.*

In view of the foregoing, withdrawal of this rejection is respectfully requested.

#### **IV. Rejection of Claims 6 and 12 Under 35 U.S.C. § 103(a)**

Claims 6 and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of the Manual, Gormley, and U.S. Patent No. 6,184,661 (“Becker et al.”). It is respectfully submitted that the combination of the Manual, Gormley, and Becker et al. does not render unpatentable the present claims for the following reasons.

As an initial matter, the Office Action indicates that claims 7 and 12 are rejected. It is assumed that the Office Action intended to reject claims 6 and 12.

Claim 6 ultimately depends from claim 1 and therefore includes all of the features recited in claim 1. Since Becker et al. do not overcome the deficiencies noted above with respect to the combination of the Manual and Gormley, it is respectfully submitted that that the combination of the Manual, Gormley, and Becker et al. does not render unpatentable this dependent claim. *Id.*

Claim 12 ultimately depends from claim 7 and therefore includes all of the features recited in claim 7. Since Becker et al. do not overcome the deficiencies noted above with respect to the combination of the Manual and Gormley, it is respectfully submitted that that the combination of the Manual, Gormley, and Becker et al. does not render unpatentable this dependent claim. *Id.*

In view of the foregoing, withdrawal of this rejection is respectfully requested.

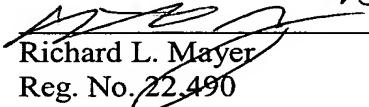
V. **Conclusion**

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

Dated: 5/13, 2005

By:

  
Richard L. Mayer  
Reg. No. 22,490

*By airmail*  
P/N 35,952

KENYON & KENYON  
One Broadway  
New York, New York 10004  
(212) 425-7200  
**CUSTOMER NO 26646**